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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,776	10/23/2000	Joseph Sforzo		8512

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,776

Applicant(s)

SFORZO, JOSEPH

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Exemplary analysis for claim 1 is provided which also applies to other independent claims.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: (1) those steps which would relate the information on a contractor and the owner/obligee to the selecting step, i.e. one or more steps which would relate the providing steps to the selecting step and presenting step; (2) step "selecting the type of bond.." requires a list of available types of bonds from the selected surety be presented; (3) proper antecedent be provided for "selecting the type of bond required" and

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"requesting approval of the bond.." (e.g. "the selected bond in the selected step").

5. claim 2 is rejected as being indefinite as particularly point out and distinctly claim the subject matter. The dependent claim does not limit any of the method claim limitation of the parent claim. (see also Claim rejection under 103(a) for further details). It is asserted that a proper dependent claim must limit one or more limitation of a parent claim. In the instant case "the contractor" is not a method step and therefore any further limitation (or attributes) of "contractor" has no effect on limitation "providing information on a contractor".

(Therefore claim 2 is interpreted as "non functional descriptive material" see 103(a) analysis below.

6. Independent claims 18, 19, 36 and 37 contain deficiencies similar to those of claim 1.

7. dependent claims 20 contain deficiencies similar to those of claim 2.

8. all dependent claims inherit deficiencies their respective independent claims upon which they depend.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igoe (US 2002/0026334) (Hereafter Igoe) and further in view of article Reliance Group Providing On-line Access to Worker's Comp, Auto Surety, Professional Liability Coverages..December 1998 hereafter Reliance.

11. Claim 1, 18, 19, 36 and 37 Igoe discloses a method (a system) of obtaining an insurance product (a bond) comprising:

providing information on a contractor that is required by a insurance carriers [surety]over a computer network;

(para [0007] p.1 information required by an insurance carriers from a user of a client computer over the Internet)

providing owner/obligee information concerning a bond over said computer network;

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(para [0007] p.1 information required by an insurance carriers from a user of a client computer over the Internet)

selecting a surety to provide the bond and presenting the identity of the surety over said computer network;

(para [0008] p.1 refer to stage 160 Agent selection page, note that selection of agent also entails selection of an insurance carrier because the agent works exclusively for one insurance companies)

selecting the type of bond required;

(para [0007] p.1 stage 110 the user selects type of insurance quote)

requesting approval of the bond over said computer network and;

(para [0007] and [0008] the information collected from the user)

obtaining a decision on the bond request over said computer network.

(para [0008] and [0009] ..a page detailing the quote details is presented to the user at stage 190).

Igoe fails to explicitly recite that the network based method for obtaining the insurance product is applied for surety bond.

However, Reliance, in the same field of endeavor, teaches an internet based surety system which teaches that

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a variety of Surety bonds (commercial bonds) are offered over a computer network.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine teachings of Igoe and Reliance so as to obtain a method offering (surety) bonds as claimed because this would allow the obligee to select a surety for a desired type of bond in accordance with individual needs from a plurality of sureties offering the commercial bonds. Benefits of such method are a convenience, efficiency and choice of selection provided by the electronic filing of surety bond request to a plurality of surety underwriters.

Furthermore, it is noted that the claimed invention is analogous to one recited in Igoe reference. In so far as the procedures and requirements of filing of surety application to one or more surety underwriters are well known, it is asserted that one of ordinary skill in the art would be motivated to adopt the Igoe method for offering Surety bonds because the later is a form insurance product and therefor analogous to Surety bond claimed.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not,

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then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

It would have been obvious to one of ordinary skill in the art at the time of invention to apply the method of Igoe for obtaining a (surety) bond for the same reasons indicated and realized in the Igoe reference.

All limitations of method claim 18 and system claim 36 have been analyzed in claim 1 analysis.

Claims 19 and 37 is a system claim and an apparatus claim respectively which correspond to method claim 1 and are accordingly analyzed.

Regarding Claims 2 and 20: Igoe and Reliance references further do not expressly show that the

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contractor is provided with an authorization code that may be presented at a bid letting along with a contractor's bid.. as per claim 2. However these differences are only found in the *nonfunctional descriptive material* and are not *functionally* involved in the steps recited for the method of obtaining a bond. The method steps (providing, selecting, presenting, requesting and obtaining) would be performed the same regardless of the limitation recited in claim 2. Thus, this *descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contractor provided with an authorization code as recited in claim 2 because the providing of the authorization code does not functionally relate to the steps in the method claimed and because the non functional description of claim 2 do not patentably distinguish the claimed invention.

This analysis also applies to dependent claim 20.

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Claims 3-16 and 21-34 are inherently covered by claim 1 and 19 because all different types of bonds are broadly interpreted in context of "bond" and "surety bond" as discussed in claim 1 analysis. Furthermore, it is noted that the type of bond have no effect on and therefor do not further limit any of the method steps of claim 1 or means of claim 19. (refer to discussion of claim 2).

Claims 17 and 35: password are inherent requirement of access to a computer network such as the Internet in view of the sensitivity of the information exchanged over the computer network.

Conclusion

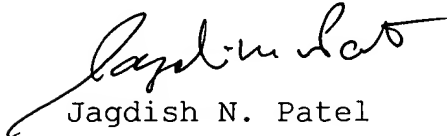
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. Draft faxes may be submitted directly to the examiner at (703) 746-5563.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

01/26/04